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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tee and Ell Weightlifting and Exercise Enterprises, Inc., dba Westside Barbell

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Serial No. 76447366

John A. Thomas of Glast, Phillips & Murray, P.C. for Tee and Ell Weightlifting and Exercise Enterprises, Inc., dba Westside Barbell.

Tracy Cross, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Simms, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

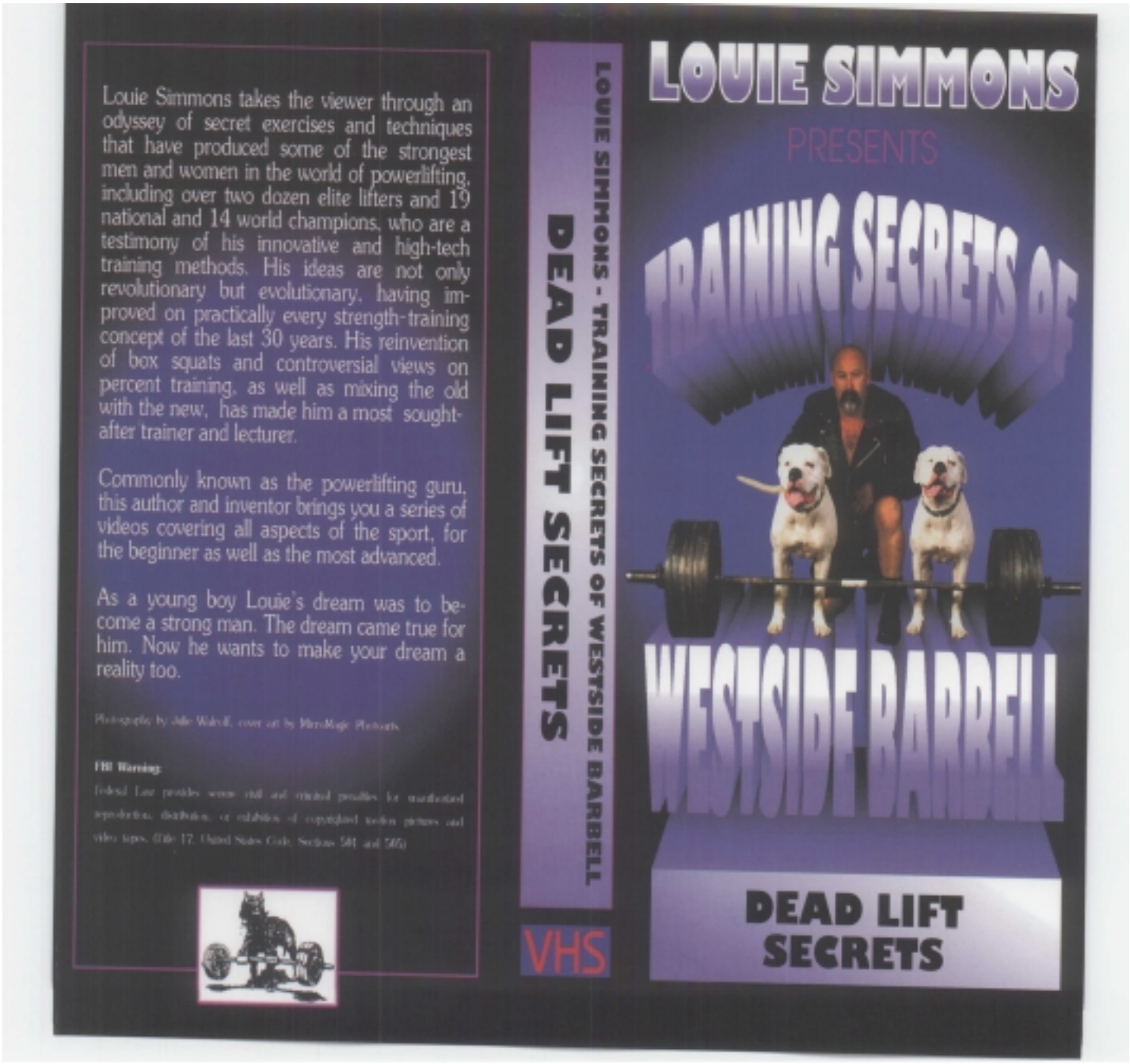
Applicant seeks registration on the Principal Register of the mark WESTSIDE BARBELL (in typed form; BARBELL disclaimed) for goods and services identified in the application as "prerecorded video tapes featuring instruction and training in the field of weightlifting," in Class 9, and "educational services, namely, training

services in the field of strength and conditioning training," in Class 41.[1]

At issue in this ex parte appeal are the Trademark Examining Attorney's final refusals to register applicant's mark on two grounds. The first ground for refusal is that the mark depicted in the application drawing is not a substantially exact representation of (i.e., it is a mutilation of) the mark as it appears on the specimens of record. *See* Trademark Rule 2.51(a)(1), 37 C.F.R. §2.51(a)(1). The second ground for refusal is that the specimens of record do not evidence use of the mark as a service mark for the recited Class 41 services.

The specimens of record applicant has submitted for its Class 9 videotapes are the labels applied to the packaging of the videotapes, a representative sample of which is reproduced below:

[1] Application Serial No. 76447366, filed on September 6, 2002. The application was filed on the basis of use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a). November 16, 1992 is alleged in the application as the date of first use anywhere and the date of first use of the mark in commerce on the Class 9 goods, and May 20, 1987 is alleged in the application as the date of first use anywhere and the date of first use in commerce of the mark in connection with the Class 41 services.


Louie Simmons takes the viewer through an odyssey of secret exercises and techniques that have produced some of the strongest men and women in the world of powerlifting, including over two dozen elite lifters and 19 national and 14 world champions, who are a testimony of his innovative and high-tech training methods. His ideas are not only revolutionary but evolutionary, having improved on practically every strength-training concept of the last 30 years. His reinvention of box squats and controversial views on percent training, as well as mixing the old with the new, has made him a most sought-after trainer and lecturer.
Commonly known as the powerlifting guru, this author and inventor brings you a series of videos covering all aspects of the sport, for the beginner as well as the most advanced.
As a young boy Louie's dream was to become a strong man. The dream came true for him. Now he wants to make your dream a reality too.
LOUIE SIMMONS - TRAINING SECRETS OF WESTSIDE BARBELL
DEAD LIFT SECRETS
VHS
LOUIE SIMMONS
PRESENTS
TRAINING SECRETS OF
WESTSIDE BARBELL
DEAD LIFT SECRETS

The specimen applicant originally submitted for the Class 41 services is an advertisement appearing in Powerlifting USA magazine, reproduced below (and enlarged):

In its request for reconsideration of the final refusal, applicant requested that the videotape labels submitted as

specimens for the Class 9 goods also be considered as specimens for the Class 41 services.

Trademark Rule 2.51(a)(1) provides, in relevant part, that "the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods [or services]." It is settled that an applicant may apply to register any element of a composite mark if that element, as shown in the record, presents a separate and distinct commercial impression which indicates the source of applicant's goods or services and distinguishes applicant's goods or services from those of others. *See, e.g., In re Chemical Dymanics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (CCPA 1950); and *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999).

In this case, the Trademark Examining Attorney contends that applicant's mark, as it appears on the specimens, is the phrase TRAINING SECRETS OF WESTSIDE BARBELL, and that the matter depicted in the application drawing, i.e., WESTSIDE BARBELL, is an incomplete representation of that mark. We disagree. Rather, we find that WESTSIDE BARBELL, as it appears on the front panel of the videotape cover specimen, is sufficiently spatially separated from the wording TRAINING SECRETS OF that it

creates its own separate and distinct commercial impression, and that it therefore may be registered as a mark. We have carefully considered the Trademark Examining Attorney's arguments to the contrary but are not persuaded. Accordingly, we reverse the refusal which is based on Trademark Rule 2.51(a)(1).

We turn next to the refusal to register the mark in Class 41 on the ground that the specimens of record do not show use of WESTSIDE BARBELL as a service mark for the recited services, i.e., "educational services, namely, training services in the field of strength and conditioning training." Our primary reviewing court has held that a "service" is "the performance of labor for the benefit of another." *In re Canadian Pacific Ltd.*, 754 F.2d 992, 994, 224 USPQ 971, 973 (Fed. Cir. 1985). The recited services clearly are a "service" under this definition, and we will presume that applicant in fact renders such services. However, the issue in this case is not whether the recited services constitute "services," or whether applicant in fact provides those services. Rather, the issue is whether the specimens of record demonstrate use of the mark as a service mark for those services.

Trademark Rule 2.56(b)(2), 37 C.F.R. §2.56(b)(2), provides that "[a] service mark specimen must show the mark

as actually used in the sale or advertising of the services." In this case, applicant's specimens clearly are not advertisements for the recited services because they do not show the requisite direct association between the mark and the recited services. *See In re Adair*, 45 USPQ2d 1211 (TTAB 1997); *In re Johnson Controls, Inc*., 33 USPQ2d 1318 (TTAB 1994). The original Class 41 specimen (the advertisement from Powerlifting USA magazine) is an advertisement for applicant's videotape series, not an advertisement for the recited services; indeed, the advertisement contains no reference to the recited services. Likewise, the videotape covers themselves are not advertisements for the recited services, because they make no reference to the services per se. The text on the back panel of the videotape cover includes references to the "exercises and techniques that have produced some of the strongest men and women in the world of powerlifting," but those references are to the content of the videotapes themselves; they are not advertisements for the recited educational services.

However, applicant contends that even if the videotape cover specimens do not show use of the mark in the advertising of the services (because they make no direct reference to the services), they nonetheless are adequate

service mark specimens because they show the mark as it is used in the course of the actual performance or rendering of the services. Applicant notes, correctly, that where the specimens show use of the mark in the rendering (as opposed to the advertising) of the services, a reference to the services on the specimen itself may not be necessary. *In re Metriplex Inc.*, 23 USPQ2d 1315 (TTAB 1992); *In re Eagle Fence Rentals, Inc.*, 231 USPQ 228 (TTAB 1986); and *In re Red Robin Enterprises, Inc.*, 222 USPQ 911 (TTAB 1984). Applicant has submitted the declaration of its president, who states, *inter alia*, that "our educational services are delivered through the content of the video series that we publish."

We are not persuaded by this argument. The Board rejected a very similar argument in the case of *In re Landmark Communications, Inc.*, 204 USPQ 692 (TTAB 1979). In that case, the applicant sought to register the mark THE DAILY BREAK as a service mark for "educational and entertainment services comprising the collection, printing, presentation and distribution of a newspaper section of cultural and leisure information" on various topics. The specimen of use submitted by the applicant was a copy of the newspaper section which bore the mark as its title, as published in the applicant's newspaper. The Board rejected

the applicant's contention that, in publishing the newspaper section, it was performing or rendering the recited services, or any service. "Applicant sells goods, not services for every individual reader." 204 USPQ at 696.

Similarly in this case, in publishing its videotape series, applicant is manufacturing and selling finished goods, not performing or rendering a service to the order of or for the benefit of individual purchasers. The purchaser is not receiving educational or training services from applicant, but rather is purchasing an educational videotape produced by applicant, i.e., a product. Just as a newspaper publisher is not rendering educational or informational services merely by publishing a newspaper section with educational content, applicant herein is not rendering educational services merely by publishing its educational videotapes.

In the above-cited cases of *In re Metriplex*, *In re Eagle Fence*, and *In re Red Robin*, the specimens were deemed acceptable because they showed how the respective marks were being used in connection with the recited services as the services were being performed, i.e., during the transmission of data via computer in *Metriplex*, during the rental of fencing in *Eagle Fence*, and during the

performance of entertainment services in *Red Robin*. In the present case, by contrast, any activity or labor performed by applicant in producing and publishing its videotape series had already concluded by the time the purchaser buys the videotapes; the purchaser is not paying for an ongoing provision of services by applicant, but rather is paying for a finished product, i.e., the videotape.

Again, the issue here is not whether applicant is in fact rendering the educational and training services recited in the application, but rather whether the specimens of record demonstrate service mark use of the mark in connection with such services. For the reasons discussed above, we find that they do not. We note that in the application, applicant stated in its "method of use clause" that it uses the WESTSIDE BARBELL mark as a service mark in advertisements for the services, and in brochures which describe the services. Such advertisements or brochures (for example, a yellow pages advertisement for applicant's Columbus, Ohio gym, or a brochure advertising or describing the training services conducted there, or an advertisement or brochure for a seminar or other event at which the recited services are actually rendered) would be acceptable service mark specimens (assuming that they display the mark at issue). However, no such

advertisements or brochures are of record, and the specimens which are of record simply do not evidence use of the mark in connection with the recited services. We therefore affirm the refusal to register the mark as to the Class 41 services.

Decision: The refusal to register the mark under Trademark Rule 2.51(a)(1) is reversed. The refusal to register the mark under Trademark Rule 2.56(b)(2) as to the Class 41 services is affirmed. The application shall proceed to publication for opposition as to the Class 9 goods identified in the application only (and not as to the Class 41 services).